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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/513,462
Filing Date: February 25, 2000
Appellant(s): LAUTENBACHER, MARKUS

MAILED

APR 19 2007

GROUP 3600

ROBERT CROCKETT
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 29th, 2005 appealing from the Office action mailed October 12th, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,073,124	Krishnan et al	6-2000
5,925,127	Ahmad	7-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

See office action dated October 12th, 2004

(10) Response to Argument

Applicant argues that the rejection of claim 11 under USC 101 if improper and should be withdrawn. Applicant further argues that software product which disclose in claim 11 is within the technological art and therefore is deemed to be statutory. Examiner respectfully disagrees with Applicant characterization of the statue. Claim 11 discloses a software product. The software product claim by the Applicant in claim 11 can simply be code. These codes can be written on a piece of paper. Applicant fails to disclose whether any machine or technology in being used along with the software product.

Claim argument

For sake of clarity a Chart or the broadest claim is provided

Claim 11

<i>Claim limitation</i>	<i>Prior art (Krishnan et al)</i>
a software component that is activated when called by said software product and that subsequently starts communicating with a usage process server and delivers usage processing data required for performing usage processing to said usage processing server in the framework of said	The DCS client includes a set of client components; support for downloading the client components onto a customer computer system; and support for communicating with the DCS server to license an item of merchandise. The client components contain a secured (e.g., encrypted) copy of the content and various components needed to license and purchase the

<p>communication, wherein said usage processing server is operated by a network provider</p> <p>wherein said software product can be downloaded into a terminal device by a user via a network in response to an inquiry from said user</p>	<p>merchandise and to unsecure (e.g., decrypt) and execute the licensed merchandise. <i>The DCS client communicates with the DCS server to download the client components onto a customer's computer system in response to a request for merchandise from the online purchasing system. The DCS client also communicates with the DCS server to license and purchase the requested merchandise. The DCS server generates an electronic license certificate, which contains license parameters (e.g., terms) that are specific to the requested merchandise and to a desired purchasing option (such as trial use, permanent purchase, or rental).</i> The DCS server then sends the generated electronic license certificate to the DCS client. Once a valid electronic license certificate for the requested merchandise is received by the DCS client, the merchandise is made available to the customer for use in accordance with the license parameters contained in the electronic license certificate.</p>
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Claim 1

<i>Claim's limitation</i>	<i>Prior art 1 (Krisham et al)</i>	<i>Prior art 2 (Ahamed)</i>
A method for using software products that are offered via a network	The secure digital commerce system interacts with an online purchasing system, such as a virtual store, to facilitate the purchase and distribution of merchandise over a network, such as the Internet or the World Wide WEB network (the WEB).	method and system for monitoring the use of a rented software program module
inquiring about a software product from an offer server by a user via a terminal device	an online virtual store that operates with the secure digital commerce system. A browser application window 201 is shown currently displaying (and executing) a WEB page 202 retrieved from the location specified by the URI "www.buysoftware.com." WEB page 202 provides a set of user interface elements, for example,	

	<p>pushbuttons 204 and 205 and icon 203 which display information or which can be used to navigate to additional information. A virtual store typically provides a set of icons, which each describe an item of merchandise that can be purchased.</p>	
downloading said software product from said offer server via said network onto said terminal device in response to said inquiring by said user	The DCS client includes a download file, a user interface library, a purchasing library, a secured content file, a DCS security information file, and licensing code.	
activating a software component of said software product; starting a communication by way of said software component with a usage processing server regarding a usage of said software product in response to a call of said software product in said terminal device of said user, wherein said usage processing server is operated by a network provider	There is a download file for each item of merchandise that can be distributed electronically, which contains an executable boot program. The boot program is responsible for determining what components need to be downloaded for a requested item of merchandise	
providing, by said software component in a framework of said communication, data to said usage processing server; and checking said data, by said usage processing server, and then making a determination selected from a group consisting of: whether usage of said software product is approved with respect to said inquiring user, and whether, charging operations are carried out on user accounts and provider of software product accounts.		Referring now to FIG. 2, a user desiring to rent a particular program module, logs onto the Internet, as discussed above, and accesses the Internet site 75a of the software rental service provider. The user then locates the rental server 80a at the Internet site 75a. The user completes a rental form provided on the server 80a and requests use of a particular program for a specified period of time. It should be understood that the form can also require payment information, such as a credit card number or an account number if the user has an

		<p>established account with the rental service provider. Program modules may be rented on a predetermined interval basis (e.g., hourly) and <u>charged</u> depending upon the length of time the user has the software checked out. Alternatively, the user may be <u>charged</u> on an hourly usage rate basis where the user is <u>charged</u> when the program module is actually running. Alternatively, a usage count rate may be used where the user rents the program module for a fixed number of uses. For example, the user may pay for ten uses of a particular program module where a single use is consumed each time the program module is run on the user's computer. It should be understood that under the latter scheme, a maximum run time will be prescribed for each use to prevent the user from running the program module indefinitely under a single use. Alternatively, a system of version rental may be employed where the user will be <u>charged</u> for use of a specified version of the rented program module. Once a new version of the program module is released, the old version rented by the user will no longer run on the user's computer.</p>
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Applicant further argues that the prior art fail to teach a "usage processing server...operated by a network provider" based in the definition provided by the applicant. Applicant define "network operator (or "network provider") operates and administers a network that primarily provides a "bit-transport" functionality. The network operator provides network connectivity for the web servers of the provider of software and contents or he may assume this function vicariously by providing a web server for the provider ("web hosting"). The network operator also provides network connectivity for the end user, normally as dial-in via a modem or ISDN, and thus normally has an established and long term business relationship with the end user: He sends the end user invoices about received network connectivity performances on a regular basis and knows his financial actions."

Applicant further argues that according to the present invention, a service provider (e.g., the network operator) assumes the usage processing, (e.g., "charging and/or access control") for the usage of software and contents. The network operator offers this as a service for the provider of software and contents, when the provider wishes to "outsource" these tasks in order to be able to concentrate on the preparation of software and contents. The provider of software and contents can also avoid the charging of very small amounts, which may not be economical for him, via "outsourcing".

Providing usage processing, such as charging and/or access control, is particularly advantageous for the network operator since the end user is already connected to the network of the network operator for purposes of the network connectivity, and therefore is in a long term business relationship with the network operator"

Examiner respectfully disagrees with Applicant. Examiner concludes that Applicant(s) are not their own lexicographer. To support his position, the Examiner notes the following: First, he Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that while Applicants may have referred to some preferred embodiments in their specification, Applicants have not pointed to *definitional* statements in their specification or prosecution history. Because Applicants have therefore not pointed to definitional statements¹ with the required clarity, deliberateness, and precision,² the Examiner concludes that Applicant(s) are not their own lexicographer.

Moreover, the prior art (Krishnan et al) taken alone or in combination with Ahmad teach a methods and systems for facilitating the purchase and delivery of electronic content using a secure digital commerce system. The secure digital commerce system interacts with an online purchasing system to purchase and distribute merchandise over a network. The secure digital commerce system is comprised of a plurality of modularized components, which communicate with each other to download, license, and potentially purchase a requested item of merchandise. An exemplary embodiment of the secure digital commerce system ("DCS") include a *DCS client and a DCS server*. The DCS client includes a plurality of client components, which are

¹ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

² "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

downloaded by a boot program onto a customer computer system in response to requesting an item of merchandise to be licensed or purchased. Although Applicant wish to dismiss the DCS server is not a network provider, Examiner take the position that the DCS server provide secure merchandise such as content over the network. For the technological fact, the DCS server is a network provider.

Applicant further argues that the prior art fail to teach or suggest “a usage processing data.” Examiner respectfully disagrees with Applicant characterization of the prior art. As indicated by the Applicant, a usage processing data require to perform usage processing.” Krishnan et al teach among other thing in exemplary embodiments, the DCS client is implemented on a computer system comprising a central processing unit, a display, a memory, and other input/output devices. Exemplary embodiments of the DCS client are designed to operate in a globally networked environment, such as a computer system that is connected to the Internet. FIG. 5 is a block diagram of a general purpose computer system for practicing embodiments of the DCS client. The computer system 501 contains a central processing unit (CPU) 502, a display 503, a computer memory (memory) 505, or other computer-readable memory medium, and other input/output devices 504. *Downloaded components of the DCS client preferably reside in the memory 505 and execute on the CPU 502. The components of the DCS client are shown after they have been downloaded and installed on the computer system 501 by an executable boot program and after an appropriate electronic license certificate has been generated and installed.* Specifically, the components of the DCS client include the executable boot program 507 (SAFEboot); a user interface library 508 (SAFEUI.dll); a purchasing request library 509 (SAFEBuy.dll); an encrypted content file 510, which is shown with incorporated

licensing code 511 (SAFE.dll); an encrypted DCS security information file 512, which is associated with the encrypted content file 510; and an electronic licensing certificate 514 (ELC). As shown, each library is typically implemented as a dynamic link library (a "DLL"). In addition to these components, when the encrypted content file contains data that is not a computer program, the memory 505 contains a content player 513 for processing the content file 510, which has incorporated licensing code 511. Also, WEB browser application code 506 is shown residing in the memory 505. Other programs 515 also reside in the memory 505. One skilled in the art will recognize that exemplary DCS client components can also be implemented in a distributed environment where the various programs shown as currently residing in the memory 505 are instead distributed among several computer systems. For example, the encrypted content file 510 may reside on a different computer system than the boot program 507.

Applicant further argues Ahmad's web server is not a network provider. Examiner respectfully disagrees. Ahmad teach a Rental service provider reside on the web server.

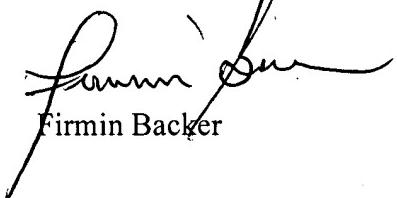
Applicant argues that the applicant respectfully submits that one of ordinary skill in the art would not have been motivated to combine the teachings of Abroad with the teachings of Krishnan. Applicant further argues that because there is no teaching or suggestion to combine the teachings of Ahmad with the teachings of Krishnan, the examiner has not made a proper *prima facie* rejection. Therefore, the rejection of claim 1 under 35 USC 103(a) over Krishnan in view of Ahmad is improper and should be reversed. Examiner respectfully disagrees with Applicant. Examiner takes the position that the rejection of claim 1 under 35 USC 103(a) over Krishnan in view of Ahmad is proper and should be maintain. Krishnan et al and Ahmad are analogous since they are in the same technological environment.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Firmin Backer

Conferees:

Vincent Millin



Andrew Fischer

